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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/863,457	05/27/97	KRISHNAMURTHI	R OCPA377CIP

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LM02/0218

EXAMINER

NGUYEN, S

ART UNIT

PAPER NUMBER

2731

DATE MAILED:

*12*  
02/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/863,459<sup>7</sup>

Applicant(s)

Krishnamurthi

Examiner

Steven Nguyen

Group Art Unit

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☒ Responsive to communication(s) filed on amendment A

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Nov 29, 1999 is ☒ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the "mobile station call origination" and "mobile station call termination" of claim 2 have no antecedent basis in the specification.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 6 and 14, it is not clear what is meant by "a glare condition."

In claims 2 and 3, the reference to the claimed message is not clear from the specification. Applicants are requested to reference the limitations of claims 2 and 3 to the specification, so metes and bounds can be determined from the claim languages. Claims 8, 9, 12 and 13 have the same problem.

### ***Claim Rejections - 35 USC § 102***

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-3, 6, 8, 9, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Spartz et al. (Spartz).

In U.S. patent No. 5,878,036 Spartz discloses a mobile switching center (MSC) 16 connected to a base station sub-system (BSS) 15 via an A-interface (Fig. 1). As shown in Fig. 6, the MSC transmits a paging signal 300 (a message signal) to the BSS when detecting a subscriber unit is being paged after another call ends (a glare condition). The BSS receives the paging signal 300 and then transmits a page message signal (a subsequent message signal) to the subscriber unit via the air interface (see col. 14). It is noted that the claimed Paging Response Message and Service Request Message have no functions to distinguish from the paging signal (Fig. 6) for a second call and the disconnect signal (Fig. 8) for a first call as two call occur in secession.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 5, 7, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spartz in view of Baldwin et al. (Baldwin).

Spartz does not explicitly recite that the paging signal and the page message signal are Alert With Information Message Signals.

In U.S. patent No. 5,633,868 Baldwin shows transmitting Alert With Information Message Signals between a wireless gateway and a subsystem of a CDMA wireless network (col. 10, lines 20-24, and Fig. 4). To use Alert With Information Message

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Signals would have been obvious to one of ordinary skill in the art because Alert With Information Messages have been widely used to represent incoming calls and other data from a base station to a mobile unit over a voice channel.

***Response to Arguments***

7. Applicant's arguments filed 11/29/99 have been fully considered but they are not persuasive.

In response to the objections of the specification of paragraph 2 and the rejection of under 35 USC 112 of paragraph 3 of previous office action which mailed 8/17/99. The application states that Page 11, line 12-14, describes a mobile phone which initiates a call being originated call and receives a call being terminated call. However, the examiner disagrees with the applicant because the limitation of claim 2 indicates two different mobile subscriber. The specification discloses only one mobile subscriber. Therefore, the rejection maintains.

Regarding claims 1-3, 6, 8, 9 and 11-13, the applicant states that Spartz et al fails to disclose a glare condition. The examiner disagrees with the applicant because the glare condition is rejected as indicated at the paragraph 5 of previous office action which mailed 8/17/99. Because the term glare condition reads on another call end.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant

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relies (i.e., the glare condition which defined in the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the rejections maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

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The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen  
Art Unit 2731  
February 10, 2000

  
CHI H. PHAM  
SUPERVISORY PATENT EXAMINER  
GROUP 2700 2/11/00